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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,013	04/10/2001	Kazuya Fujinaga	Q64034	9560
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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC		EXAMINER		
2100 PENNSYLVANIA AVENUE, N.W.		THEIN, MARIA TERESA T		
WASHINGTON, DC 20037-3213		ART UNIT PAPER NUMBER		
		3627		

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/829,013

Applicant(s)

FUJINAGA ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Applicants' "Amendment under 37 C.F.R. § 1.111" filed on October 28, 2005 has been considered.

Applicants' response by virtue of amendment to claims 1 and 7 has overcome the Examiner's rejection under 35 USC 112, second paragraph.

Claims 1, 7, and 15 are amended. Claims 1-20 remain pending in this application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,141,653 to Conklin et al. in view of U.S. Patent NO. 6,233,566 to Levine et al.**

Regarding claims 1, 7-8, and 15, Conklin discloses an e-commerce brokering method and system for mediating commerce (sponsor) between a plurality of suppliers and a buyer comprising:

- storing public data and non-public data in database of an agent, the public data containing standardized attribute information about a product supplied by the plurality of suppliers, the public data able to be viewed so as to compare the

attribute information of each suppliers' product (a sponsor database; Figures 1f and 1g), the non-public data comprising set of transaction rules set for each combination of a supplier and the buyer (confidential data is transmitted securely to the browser through SSL techniques, wherein access to the data is by user name and password, col. 26, lines 6-10; when participants log into their protected areas in the system's databases 225, they are presented with information regarding the latest development, if any, which have occurred in their respective negotiations, col. 26, lines 14-18); and

- applying to the agent for a transaction of a selected product, wherein the buyer selects a product from the database via the data communication network (placement of an order from a buyer, col. 23, lines 51-52; a buyer may want to know whether it can purchase such a product in high quantities at a reasonable price from any seller, col. 25, lines 30-34);
- the buyer has applies for a transaction (Letter of Credit), the agent reads transaction rules applicable to each combination of buyer and supplier of the selected product from the non-public data, prepares cost estimates, and presents the cost estimates to the buyer (col. 23, lines 51-67; col. 24, lines 1-9; col. 25, lines 5-11; Figure 16); and
- the buyer selects a supplier on the basis of the cost estimate and the agent carries out an ordering procedure on the basis of the purchase condition (Figures 16-18);

Furthermore, Conklin discloses starting negotiations with the supplier on the basis of the cost estimate to determine purchase conditions and a supplier (multivariate negotiation engine); ordering the selected product, wherein the agent carries out the ordering procedures for the buyer and the supplier on the basis of the negotiated purchase (Figures 16-18); and the purchase conditions stored in the non-public data are replaced by the negotiated purchase conditions (col. 24, lines 18-22).

However, Conklin does not explicitly disclose wherein at least one set of said transaction rules is established by a respective combination of supplier and buyer prior to the buyer's selection of a product supplied by the plurality of supplier. Conklin discloses the sponsoring standards body proposes initial standards. Conklin further discloses a sponsor, such as a traditional stock exchange or a new type of securities body could establish the standards for accepting stockbrokers into the community. Such standards might include compliance with applicable securities regulation. (Col. 17, lines 60-64)

Levine, on the other hand, teaches wherein at least one set of said transaction rules is established by a respective combination of supplier and buyer prior to the buyer's selection of a product supplied by the plurality of supplier (col. 6, lines 15-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and system of Conklin, to include the least one set of said transaction rules is established by a respective combination of supplier and buyer prior to the buyer's selection of a product supplied by the plurality of

supplier, as taught by Levine, in order to provide the right type of products, thus creating an efficient market for trading products (Levine, col. 2, lines 16-18).

Regarding claims 2-3, 9-10, 13, 17 and 19, Conklin discloses where the database stores of conversion data indicating corresponding between code systems of different suppliers, wherein the code system of each supplier includes customer codes and product part numbers; and the storing conversion data including customer codes varying according to a supplier and product part numbers (see at least col. 28, lines 23-29).

Regarding claims 4-6, 11-12, and 14, Conklin discloses the buyer can view the public data cost-free (these browsers are distributed free of charge by their supplier); the supplier registers, updates, maintains and administers the public data stored in the database (08grpa in Figure 1k); and the agent stores a record of the ordering procedures in storage means whose data cannot be altered (sponsor's database, col. 32, line 54-col. 33, line 6); and wherein the buyer determines a supplier and purchase conditions via bidding conducted by the agent, individual negotiations or an auction with the supplier of the same products or services (col. 23, lines 43-58).

Regarding claims 16 and 18, Conklin discloses the database stores public data able to be viewed by standardizing attribute information about the same products supplied by the plurality of supplier so as to compare the attribute information with each other (Figures 1f, 1j and 1g).

Regarding claim 20, Conklin discloses an e-commerce broking method comprising: providing a database that stores public data and non-public data, the public

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data comprising standardized attribute information about the same kind of products supplied from the plurality of suppliers, and the non-public data comprising sets of transaction rules for each combination of a supplier and a buyer (confidential data is transmitted securely to the browser through SSL techniques, wherein access to the data is by user name and password, col. 26, lines 6-10; when participants log into their protected areas in the system's databases 225, they are presented with information regarding the latest development, if any, which have occurred in their respective negotiations, col. 26, lines 14-18); presenting the public data to a buyer site (col. 19, lines 39-67); receiving an application from the buyer (Letter of Credit); reading the transaction rules set for the buyer and the selected supplier, and making a cost estimate to send to the buyer (Figures 16-20); receiving a decision from the buyer site, the decision containing a supplier from which the buyer purchases the desired product and purchase conditions determined on the basis of the cost estimate (Figures 16-20); and conducting ordering procedures (purchase order; Figures 16-20).

However, Conklin does not explicitly disclose wherein at least one set of said transaction rules is established by a respective combination of supplier and buyer prior to the buyer's selection of a product supplied by the plurality of supplier. Conklin discloses the sponsoring standards body proposes initial standards. Conklin further discloses a sponsor, such as a traditional stock exchange or a new type of securities body could establish the standards for accepting stockbrokers into the community. Such standards might include compliance with applicable securities regulation. (Col. 17, lines 60-64)

Levine, on the other hand, teaches wherein at least one set of said transaction rules is established by a respective combination of supplier and buyer prior to the buyer's selection of a product supplied by the plurality of supplier (col. 6, lines 15-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and system of Conklin, to include the least one set of said transaction rules is established by a respective combination of supplier and buyer prior to the buyer's selection of a product supplied by the plurality of supplier, as taught by Levine, in order to provide the right type of products, thus creating an efficient market for trading products (Levine, col. 2, lines 16-18).

### ***Response to Arguments***

Applicant's arguments filed October 28, 2005 have been fully considered but they are not persuasive.

Applicants remark that "the combination of Conklin et al. and Levine et al. fails to teach or suggest at least non-public data comprising at least one set of transaction rules for a combination of supplier and buyer, wherein the transaction rules are agreed to by the combination of supplier and buyer prior to the buyer's selection of a product, as recited in claim 1".

The Examiner note that Conklin was cited for disclosing the non-public data comprising at least one set of transaction rules for a combination of supplier and buyer. In col. 17, lines 46-48 and col. 19, lines 45-46, Conklin discloses the sponsoring standards establishes the community with set standards and rules for negotiations. The sponsor establishes more detailed rules for the ordering and processing of proposals



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(col. 23, lines 65-67). Conklin further discloses a negotiation process wherein both the buyer and seller propose terms back and forth (col. 25, lines 13-14; col. 25, lines 38-40).

A buyer proposal may include document presentation terms and detailed terms of the buyer's preferences for shipment; and buyer's comments such as a buyer wanting a 20% discount (col. 25, lines 41-50). The buyer may further have additional terms such as warranty and indemnity terms favorable to the buyer (col. 25, lines 50-54).

Furthermore, Conklin discloses confidential data which is transmitted securely wherein access to the data is by user name and password (col. 26, lines 6-10). Moreover, Conklin discloses that when participants log into their protected areas in the system's databases, they are presented information regarding respective negotiations (col. 26, lines 14-19).

Such rules for negotiations; establishing more detailed rules for the ordering and processing of proposals; a negotiation process wherein both the buyer and seller propose terms back and forth, which includes terms favorable to the buyer; confidential data transmitted securely where access to the data is by user name and password; and when participants log into their protected areas in the system's databases are considered non-public data comprising at least one set of transaction rules for a combination of supplier and buyer.

The Examiner then turns to Levine for teaching the rules are established prior to the buyer's selection of a product supplied by the plurality of suppliers. Conklin does disclose a buyer proposal form is filled out before the proposal is sent to the seller (col. 25, lines 60-62). The buyer proposal includes terms that are favorable to the buyer (col.

25, lines 46-54). Conklin does not explicitly disclose the rules are established prior to the buyer's selection of a product supplied by the plurality of suppliers. Levine discloses pre-set rules to match potential buyers with sellers (abstract). Furthermore, Levine discloses an example of a pre-set rule that a buyer may use if the buyer wants to purchase a service or product based on a percentage or ratio that is greater than or less than the standard the buyer has proposed (col. 9, lines 40-42).

Such pre-set rules to match potential buyers with sellers and a pre-set rule that a buyer may use if the buyer wants to purchase a service or product based on a percentage or ratio that is greater than or less than the standard the buyer has proposed are considered rules established prior to buyer's selection of a product supplied by the plurality of suppliers.

Applicants remark that "one of ordinary skill in the art would not be motivated to combine the references".

In response to applicants' remark that there is no motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in Levine col. 2, lines 16-18.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mtot  
January 4, 2005

A handwritten signature in black ink, appearing to read "SFB. McAllister".

STEVE B. MCALLISTER  
PRIMARY EXAMINER